

REMARKS

Reconsideration and allowance of the above-captioned patent application are respectfully requested. This application relates to selective spirocyclic glucocorticoid receptor modulators.

Status of Claims

Claims 1 to 23 are currently pending in the application. Claims 1 to 7, 22 and 23 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1 to 7, 22 and 23 have been rejected for non-enablement under 35 U.S.C. § 112, first paragraph. Claims 1 to 4, 6 to 8, 17, 21 and 22 have been rejected as anticipated by US 2005/0256315 ("Ali") and US 2005/0054700 ("Scanlan"). Claims 9 to 16 and 18 to 20 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. This indication of allowability is appreciatively acknowledged. Claims 14, 15 and 16 to 20 have been rejected for not ending in a period. No claim has been allowed.

This Amendment cancels Claims 1 to 7, 15 to 21 and 23, amends Claims 8 to 12, 14 and 22 and adds new Claims 28 and 29. Upon entry of this Amendment, claims in the application will be Claims 8 to 14, 22, 28 and 29. All objections and rejection pertaining to Claims 1 to 7, 15 to 21 and 23 are rendered moot by their cancellation. The cancellation of claims was made to advance prosecution of the subject application. Applicants reserve the right to prosecute canceled subject matter in one or more future continuation applications.

Written Description and Enablement

Claims 1 to 7 and 23 have been canceled rendering the corresponding written description and enablement rejections moot. Claim 22 has been amended to depend from Claim 11, which overcomes the written description and enablement rejection for this claim. Withdrawal of the written description and enablement rejections is therefore respectfully requested.

Anticipation

The anticipation rejection of Claims 1 to 4, 6, 7, 17 and 21 has been rendered moot by their cancellation.

Claim 8 has been amended to claim pharmaceutical compositions. Ali and Scanlan disclose the compound cited by the Examiner as an intermediate and thus do not teach or suggest this compound as part of a pharmaceutical composition. New Claims 28 and 29 are also directed to pharmaceutical compositions comprising this compound. As Ali and Scanlan fail to teach each and every element of the claimed invention, withdrawal of the anticipation rejection is respectfully requested.

Claims 17 and 21 have been canceled and combined, in part, with Claim 14, without the compound cited above.

Claim 22 has been amended to depend from Claim 11 thus overcoming the anticipation rejection of this claim.

Claims 9 and 10 have also been rewritten as pharmaceutical composition claims.

Claim Objections

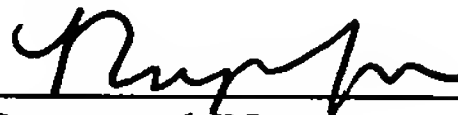
Claims 8, 11 and 14 have been rewritten in independent form such that no pending claim depends from a rejected base claim. Claims 15 to 21 have been combined with Claim 14, excluding the compound cited by the Examiner, and ends in a period. All objections have been overcome.

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Final Remarks

Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

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Date: October 24, 2007

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